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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/710,999	11/09/2000	Tetsunosuke Fujisaki	YO999-527	5835
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EXAMINER SUBRAMANIAN, NARAYANSWAMY				
ART UNIT		PAPER NUMBER		
3695				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary**Application No.**

09/710,999

Applicant(s)

FUJISAKI, TETSUNOSUKE

Examiner

Narayanswamy Subramanian

Art Unit

3695

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 January 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 4, 5, 17, 18, 20, 21 and 32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-2, 4-5, 17-18, 20-21, 32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE/C.3)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This office action is in response to applicant's request for continued examination of January 4, 2010. Amendments to claims 1, 17, 32 and cancellation of claims 3 and 19 have been entered. Claims 1-2, 4-5, 17-18, 20-21, 32 are pending and have been examined. The rejections and response to arguments are stated below.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-2, 4-5, 17-18, 20-21, 32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "wherein at least one of said steps is performed by a processor". It is unclear which of the steps of the claim are performed by a processor. Hence the scope of the claim is unclear. Claims 2 and 4-5 are rejected by way of dependency on a rejected independent claim.

Claims 1, 17 and 32 recite the limitations "comparing said bid to other pending bids to identify pending bids that are in proximity to said received bid" and "posting said bid only to said one or more authorized market segments". It is not clear as to what is the relationship between the comparing step and the posting step. Is the posting performed independently and regardless of the outcome of the comparing step or is the posting based on the outcome of the comparing step? In view of these ambiguities the scope of the claim is unclear. Dependent claims are rejected by way of dependency on a rejected independent claim.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-2, 4-5, 17-18, 20-21, 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Woolston (US Patent 6,266,651 B1) in view of Silverman et al. (US Patent 5,924,082) and further in view of Gary (US Patent 6,618,707 B1).

With reference to claims 1, 17 and 32, Woolston teaches a method, a system and an article of manufacture respectively for processing transactions in a secondary market, the method comprising the steps of establishing a plurality of market segments in said secondary market, each of said market segments having at least one market participant (See Woolston Column 1 lines 51-67, the tiers constitute the market segments and used goods imply secondary markets); receiving a bid for one or more goods, said bid including one or more authorized market segments (See Woolston claim 35, receiving bids from retail segment is implied in the disclosure); and posting said bid only to said one or more authorized market segments, wherein at least one of said steps is performed by a processor (See Woolston claims 5 and 18, privileges available to only one segment is interpreted to include this feature). A system for processing transactions, comprising a memory that stores computer-readable code and a processor operatively coupled to said memory and an article of manufacture comprising a computer readable medium having computer readable code means embodied thereon are

inherent in the disclosure of Woolston. The Dictionary of Banking Terms defines "a secondary market as the market where existing loans, and other assets are sold to investors, either directly or through an intermediary". Hence the market for used goods and collectibles disclosed in Woolston qualifies as a secondary market.

Woolston does not teach the feature wherein the goods are financial securities and comparing a received bid to other pending bids to identify pending bids that are in proximity to said received bid. Silverman teaches the feature wherein the goods are financial securities (See Silverman Column 3 lines 50-55).

Both Woolston and Silverman are concerned with the problem of processing transactions involving two parties. It would have been obvious to one with ordinary skill in the art at the time the invention was made to include the feature taught by Silverman to the invention of Woolston. The motivation to combine is that parties to the transaction would have benefited from being able to communicate and negotiate other terms with each other before finalizing the transaction.

Gary teaches the step of comparing a received bid to other pending bids to identify pending bids that are in proximity to said received bid (See the entire disclosure of Gary especially Figures 4A-5B and associated portions of the specification, Column 16 lines 17-60, Column 17 line 1- Column 18 line 44).

It would have been obvious to one with ordinary skill in the art at the time the invention was made to include the feature taught by Gary to the invention of Woolston. The motivation to combine is that it helps in improving liquidity and assure fair handling of orders (See Gary Column 4 lines 49-51)

With reference to claims 2, and 18, Woolston teaches the steps of preventing said bid from being posted to market participants not in said one or more authorized market segments (See Woolston Claims 5 and 18, privileges available to only one segment is interpreted to include the step of preventing said bid from being posted to market participants not in said one or more authorized market segments).

With reference to claims 4 and 20, Silverman teaches the step of establishing a communication channel between entities associated with two bids that are in proximity (See Silverman Column 3 lines 40-44 and 60-64).

With reference to claims 5 and 21, Silverman teaches the step wherein two bids are in proximity if they have parameters that are within a given threshold of each other (See Silverman Column 4 lines 35-47). This feature is also taught by Gary (See the entire disclosure of Gary especially Column 19 line 47- Column 22 line 14, number of ticks is an example of the threshold).

Response to Arguments

6. Applicant's arguments with respect to pending claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure are listed on the enclosed PTO-892.

8. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Narayanswamy Subramanian whose telephone number is (571) 272-6751. The examiner can normally be reached Monday-Thursday from 8:30 AM to 7:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles R. Kyle can be reached at (571) 272-6746. The fax number for Formal or Official faxes and Draft to the Patent Office is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PMR or Public PAIR. Status information for unpublished applications is available through Private PMR only. For more information about the PMR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Narayanswamy Subramanian/
Primary Examiner
Art Unit 3695

February 15, 2010